



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*SN*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/654,929 09/05/00 AKIYAMA

R 1046.1100RE

021171  
STAAS & HALSEY LLP  
700 11TH STREET, NW  
SUITE 500  
WASHINGTON DC 20001

TM02/0208

EXAMINER

DIXON, T

ART UNIT PAPER NUMBER

2161

DATE MAILED:

02/08/01

*2*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/654,929	AKIYAMA ET AL.
Examiner	Art Unit	
Thomas A. Dixon	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 September 2000.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-7 is/are allowed.
- 6) Claim(s) 8-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 September 2000 is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. 08/510,122.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Application 09/654,929 is a reissue application based upon application 08/510,122, now US Patent No. 5,812,661.
2. Examiner requests applicant file IDS as filed in the parent application.
3. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed.

See 37 CFR 1.178.

#### ***Oath/Declaration***

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

- a. It does not state whether the inventor is a sole or joint inventor of the invention claimed.
- b. The nature of the defect(s) in the declaration is that the error set forth as the basis for the Reissue application is based on improper recapture. Specifically, the "input switchover" and "output switchover", argued as the error which forms the basis for the reissue application, were added to the original claims and argued by applicant as the distinguishing features of the claims in both amendments B, filed 6 May 1997, and C, filed 8 December 1997, of the parent application. Therefore, correction constitutes improper recapture and cannot form the basis of a reissue application.

5. Claims 1-22 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

***Improper Recapture***

6. Claims 8-22 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Specifically, the “signal processor...”, “error processing means”, “a first and second input switchover” and “output route switchover for receiving encrypted and non-encrypted data”, were added to the original claims and argued by applicant as the distinguishing features of the claims in both amendments B, filed 6 May 1997, and C, filed 8 December 1997, of the parent application, and therefore constitute improper recapture.

***Drawings***

7. The drawings are objected to because Figure 2, (70) is labeled VRC, while the specification, column 7, line 6 refers to it as (VCR) it is therefore confusing .

Correction is required.

***Specification***

8. The disclosure is objected to because of the following informalities:

Figure 2, (70) is labeled VRC, while the specification, column 7, line 6 refers to it as (VCR) it is therefore confusing .

Appropriate correction is required.

***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 8,12,16,20,21,22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically the terms "visible and audible" are not supported by the specification. The terms in the specification are "image and sound"

The claims which depend from the above are rejected for at least the same reason.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2161

10. Claims 8,12,16,20,21,22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, each of the claims contain the phrase "at least one of the group consisting of visible and audible data". The claims should refer in the alternative "or" or require both types of data.

Claims 21 and 22, line 4, the phrase "converter that converts converts" is confusing.

The claims which depend from the above are rejected for at least the same reason.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. Claims 8-10, 12-14, 16-18, 20, 21, 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Shear (5,510,498).

As per Claim 8.

Shear ('598) discloses:

a digital information receiving means, see figure 3 (304);

drive means for reading digital information from and writing digital information to a removable storage medium, see (308) and Column 13, lines 30-54;

information converting means for converting digital information received into at least one of visible or audible data, see (316) and Column 20, lines 31-40;

switch means for controlling a connection between receiving means and converting means and said drive means, see (308).

Art Unit: 2161

As per Claim 9.

Shear ('598) discloses all the limitations of Claim 8.

Shear ('598) further discloses:

a deciphering means for deciphering digital information received by receiving means when information is ciphered and for providing the deciphered digital information to said information converting means, see figure 3 (310, 316),

and for deciphering digital information read by said drive means when the information is ciphered and for providing the deciphered information to said information converting means, see (308, 310, 316).

As per Claim 10.

Shear ('598) discloses all the limitations of Claim 9.

Shear ('598) further discloses billing managing means for managing billing, see figure 1 (300) based on utilization of digital information received and read, see column 9, lines 26-46.

As per Claim 12.

Shear ('598) discloses:

a digital information receiver, see figure 3 (304);

a drive device reading digital information from and writing digital information to a removable storage medium, see (308) and Column 13, lines 30-54;

a converter converting digital information received into at least one of visible or audible data, see (316) and Column 20, lines 31-40;

a switch controlling a connection between receiving means and converting means and said drive means, see (308).

As per Claim 13.

Shear ('598) discloses all the limitations of Claim 12.

Shear ('598) further discloses:

a decipherer device deciphering digital information received by receiving means when information is ciphered and for providing the deciphered digital information to said information converting means, see figure 3 (310, 316),

and for deciphering digital information read by said drive means when the information is ciphered and for providing the deciphered information to said information converting means, see (308, 310, 316).

As per Claim 14.

Shear ('598) discloses all the limitations of Claim 13.

Shear ('598) further discloses billing managing device managing billing, see figure 1 (300) based on utilization of digital information received and read, see column 9, lines 26-46.

As per Claim 16.

Shear ('598) discloses:

Art Unit: 2161

a communication path, see Figure 3 (connector to host computer)

a storage medium storing digital data, see figure 1 (100);

a converter converting digital information received into at least one of visible or audible data, see figure 3 (316) and Column 20, lines 31-40;

a switch having

a first switch position which connects digital data provided by the communication path to the converter so that the converter converts the digital data into at least visible or audible data, see figure 3 (304, 308, 316);

a second switch position which connects digital data read from the storage medium to the converter so that the converter converts the digital data read from the storage medium into at least visible or audible data, see figure 1 (100), figure 3 (304, 308, 316), and

a third switch position which connects digital data provided by the communication path to the storage media so that the digital data provided via the communication path is stored in the storage medium, see Column 9, lines 47-57.

As per Claim 17.

Shear ('598) discloses all the limitations of Claim 16.

Shear ('598) further discloses:

a deciphering device which

deciphers digital information received by receiver when information is ciphered and for providing the deciphered digital information to said information converter, see figure 3 (310, 316),

and deciphers digital information read by said drive when the information is ciphered and for providing the deciphered information to said information converter, see (308, 310, 316).

As per Claim 18.

Shear ('598) discloses all the limitations of Claim 16.

Shear ('598) further discloses billing managing device managing billing, see figure 1 (300) based on utilization of digital information received and read, see column 9, lines 26-46.

As per Claim 20.

Shear ('598) discloses:

a communication path, see Figure 3 (connector to host computer)

a storage medium storing digital data, see figure 1 (100);

a converter converting digital information received into at least one of visible or audible data, see figure 3 (316) and Column 20, lines 31-40;

a switch having

a first switch position which, when non encrypted data is provided, connects digital data provided by the communication path to the converter so that the converter converts the digital data into at least visible or audible data, see figure 3 (304, 308, 316);

Art Unit: 2161

a second switch position which, when encrypted digital data is provided, connects digital information provided to the converter and the decoder and then the digital data is decoded by the decoder and converted by the converter into at least visible or audible data, see figure 3 (310, 316);

a third switch position which, non encrypted digital data is read from the storage medium connects converter so that the converter converts the digital data read from the storage medium into at least visible or audible data, see figure 1 (100), figure 3 (304, 308, 316), and

a fourth switch position which, when encrypted digital data is read from the storage medium, when encrypted digital data is provided, connects digital information provided from the storage medium to the converter and the decoder and then the digital data is decoded by the decoder and converted by the converter into at least visible or audible data, see figure 1 (100), figure 3 (304, 308, 310, 316);

a fifth switch position which connects digital data provided by the communication path to the storage media so that the digital data provided via the communication path is stored in the storage medium, see Column 9, lines 47-57.

As per Claim 21.

Shear ('598) discloses:

a first switch position which connects digital data provided by the communication path to the converter so that the converter converts the digital data into at least visible or audible data, see figure 3 (304, 308, 316);

a second switch position which connects digital data read from the storage medium to the converter so that the converter converts the digital data read from the storage medium into at least visible or audible data, see figure 1 (100), figure 3 (304, 308, 316), and

a third switch position which connects digital data provided by the communication path to the storage media so that the digital data provided via the communication path is stored in the storage medium, see Column 9, lines 47-57.

As per Claim 22.

Shear ('598) discloses:

a first means which connects digital data provided by the communication path to the converter so that the converter converts the digital data into at least visible or audible data, see figure 3 (304, 308, 316);

a second means which connects digital data read from the storage medium to the converter so that the converter converts the digital data read from the storage medium into at least visible or audible data, see figure 1 (100), figure 3 (304, 308, 316), and

a third means which connects digital data provided by the communication path to the storage media so that the digital data provided via the communication path is stored in the storage medium, see Column 9, lines 47-57.

***Claim Rejections - 35 USC § 103***

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 11, 15, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear (5,410,598) in view of Allen (5,418,713).

As per Claim 11.

Shear ('598) discloses all the limitations of Claim 8.

Shear ('598) does not specifically disclose extension means for extending digital information received by said digital information receiving means when said digital information is compressed,

and for extending said digital information read by said drive means when said digital information is compressed.

Allen ('713) teaches compression, see figure 2 (7) and decompression, see figure 6 (169), for the storage and exchange of digital video/graphic data files for the benefit of faster transfer times.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Shear ('498) to include compression and

Art Unit: 2161

decompression of digital information as taught by Allen ('713) for the benefit of faster transfer times.

As per Claim 15.

Shear ('598) discloses all the limitations of Claim 12.

Shear ('598) does not specifically disclose extender extending digital information received by said digital information receiving means when said digital information is compressed,

and extending said digital information read by said drive means when said digital information is compressed.

Allen ('713) teaches data compression, see figure 2 (7) and decompression, see figure 6 (169), for the storage and exchange of digital video/graphic data files for the benefit of faster transfer times.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Shear ('498) to include compression and decompression of digital information as taught by Allen ('713) for the benefit of faster transfer times.

As per Claim 19.

Shear ('598) discloses all the limitations of Claim 16.

Shear ('598) does not specifically disclose extender extending digital information received by said digital information receiving means when said digital information is compressed,

and extending said digital information read by said drive means when said digital information is compressed.

Allen ('713) teaches data compression, see figure 2 (7) and decompression, see figure 6 (169), for the storage and exchange of digital video/graphic data files for the benefit of faster transfer times.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Shear ('498) to include compression and decompression of digital information as taught by Allen ('713) for the benefit of faster transfer times.

### ***Allowable Subject Matter***

14. Claims 1-7 are allowable, Arnold et al (4,558,176) in view of Hartman Jr (5,224,166) does not disclose a "signal processor", "error processing means", "a first and second input switchover" and "output route switchover for receiving encrypted and

non-encrypted data" as claimed, but remain rejected to under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Friday 7 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 305-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

TAD  
  
February 1, 2001